

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant:	Ricky W. Purcell	Examiner:	Tarla Patel
Serial No.:	10/650,407	Group Art Unit:	3772
Filed:	August 27, 2003	Docket:	1443.052US1
Title:	ADJUSTABLE TEMPERATURE HEAT PATCH		

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

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Commissioner for Patents  
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Alexandria, VA 22313-1450

The Appellant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested for the reason(s) stated below:

Claims 1-2, 4, 7 and 8 were rejected under 35 U.S.C. § 102(b) for anticipation by Zhang et al. (US 5,658,583). The Final Office Action states at page 2 that "Zhang et al. discloses a heat patch comprising of an enclosure having gas-permeable first layer (26) and second layer (16) bonded together . . ." In addition, the Advisory Office Action states at page 2 that:

"The examiner believes that Zhang's characterization of structure 22, as shown in the figures and column 6, depicts the structure as a whole. Further, column 6 lines 10-13 discloses a semi-permeable membrane to be part of the structure or surface of the device (22) column 6, lines 22-28. As shown in figures 1 and 2, membrane (26) has layer 16 bonded to or attached to the bottom of membrane (26). Therefore, the combination of membrane (26) and layer (16) forms an enclosure to hold heating composition (28) as shown in figures 1 and 2 and column 5, line 66-column 6 line 28."

Appellant respectfully traverses these assertions in part because reference numeral 26 refers to openings in a structure 22 which caps heat generating chamber 14. (See col. 6, lines 3-9 of Zhang). Appellant also respectfully directs attention to col. 5, lines 54-59; col. 6, lines 43-44 and FIG. 1 of Zhang which demonstrate that the enclosure for the heat-generating chamber is formed of structure 22 and non-permeable wall 16.

Appellant further notes that while the perimeter of the non-permeable wall 16 is attached to structure 22, the perimeter of structure 22 is not attached to non-permeable wall 16. Therefore, Appellant respectfully submits that Zhang does not teach or suggest "an enclosure that includes a gas-permeable first layer and a second layer such that a perimeter of said gas-permeable first layer is bonded to a perimeter of said second layer" as recited in claim 1.

Claims 5-6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Zhang et al. in view of Argaud (US 4,963,360). Appellant notes that Argaud also does not describe "an enclosure that

includes a gas-permeable first layer and a second layer such that a perimeter of said gas-permeable first layer is bonded to a perimeter of said second layer” as recited in claim 1. Claims 5-6 depend from claim 1 and as such incorporate all of the limitations of claim 1.

Claims 9-12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Zhang et al. in view of Kuratomi (US 4,747,841). Appellant notes that Kuratomi also does not describe “wherein said entire first layer is gas-permeable” as recited in claim 1. Claims 9-12 depend indirectly from claim 1 and as such incorporate all of the limitations of claim 1.

Claim 13 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Zhang et al. as applied to claims 9-12, further in view of Ingram (US 5,366,491).

***I. Zhang, Kuratomi and Ingram do not teach or suggest every element of claim 13***

As discussed above, Zhang and Kuratomi do not teach or suggest “an enclosure that includes a gas-permeable first layer and a second layer such that a perimeter of said gas-permeable first layer is bonded to a perimeter of said second layer” in combination with “wherein said entire first layer is gas-permeable” as recited in claim 1. Appellant notes that Ingram also does not describe “an enclosure that includes a gas-permeable first layer and a second layer such that a perimeter of said gas-permeable first layer is bonded to a perimeter of said second layer” in combination with “wherein said entire first layer is gas-permeable” as recited in claim 1. Claim 13 depends from claim 1, and as such incorporates all of the limitations of claim 1.

In addition, the Examiner acknowledges at page 6 of the Final Office Action that “however Zhang and Kuratomi do not disclose a heat patch having plurality of portions with information related to heat generated by the heat patch when one or more portions is removed from the first layer.” The Examiner attempts to overcome the acknowledged deficiencies of Zhang and Kuratomi by combining Zhang and Kuratomi with Ingram.

Appellant notes that the liquid crystal temperature-indicating strip (22) disclosed in Ingram monitors and displays the temperature of the skin. Appellant initially submits that the strip 22 is not attached to a gas-permeable first layer.

In addition, the disclosed strip 22 is not meant to be removed from the heat pack 1 such that (i) the strip 22 is not detachably connected to the heat patch 1; and (ii) the strip does not provide information as to what happens when the strip 22 is removed because the strip is not meant to be removed. Appellant also submits that the strip 22 does not provide information as to what would happen if the strip 22 were removed from the heat pack 1. Therefore, Ingram does not describe “wherein at least one of said plurality of portions includes information related to heat generated by the heat patch when one or more of said plurality of portions is removed from said gas-permeable first layer” as recited in claim 13.

II. *There is no objective evidence to combine Zhang, Kuratomi and Ingram*

The Final Office Action states at page 7 that:

“it would have been obvious to one skilled in the art to modify the heat patch of Kuratomi and Zhang to include the temperature indicating strip of the Ingram's heat patch to allow monitoring the use of the heat patch for therapeutic level without damaging the user's skin with higher temperature.”

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Appellant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP § 2143. The Examiner must avoid hindsight. *In re Bond*, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990).

Often, it will be necessary . . . to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements. In the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit. *KSR Int'l Co. V. Teleflex, Inc., No 04-1350 (U.S. Apr. 30, 2007)* (see *KSR slip op. at 14*).

These statements in *KSR* appear to reinforce the statements which were made in *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) that the Examiner must show that some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teaching of the references. These statements in *KSR* also appear to reinforce the statements made in *In re Sang Su Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002) which indicate that the Office Action must further provide specific, objective evidence of record for finding a reason to combine reference teachings and must explain the reasoning by which the evidence is deemed to support such a finding. Mere conclusory statements are unsatisfactory.

“With respect to Lee's application, neither the examiner nor the Board adequately supported the selection and combination of the Nortrup and Thunderchopper references to render obvious that which Lee described. The examiner's conclusory statements that ‘the demonstration mode is just a programmable feature which can be used in many different devices for providing automatic introduction by adding the proper programming software’ and that ‘another motivation would be that the automatic demonstration mode is user friendly and it functions as tutorial’ do not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill in the art would have been lead to this combination of references, simply to use ‘[use] that which the inventor taught against its teacher.’ *W.L. Gore V. Garlock, Inc.*, 721 F. 2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983).” *Lee*, at 1343, 1344.

Appellant respectfully submits that the Examiner's statement regarding motivation is analogous

to the conclusory statements made by the Examiner and Board in the *In re Lee* case. In addition, Appellant notes that the Examiner does not cite any authority for the assertion.

Appellant further submits that the only description as to (i) the entire first layer being gas-permeable; (ii) where the gas-impermeable cover includes a plurality of portions that are detachably mounted to the outer surface of the gas-permeable first layer; and (iii) one of the plurality of portions including information related to heat generated by the heat patch when one or more of the plurality of portions is removed from the gas-permeable first layer is found in Appellant's specification and claims. Appellant also fails to see how the strip 22 disclosed in Ingram would display proper information if the strip 22 were removed from the heat pack 1 as recited in the claims.

Claims 14 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Zhang et al. and Ingram, as applied to claim 13 above, further in view of Lachenbruch (US 6,755,852).

***I. Zhang, Kuratomi, Ingram and Lachenbruch do not teach or suggest every element of claim 14***

Appellant notes that Lachenbruch also does not describe "an enclosure that includes a gas-permeable first layer and a second layer such that a perimeter of said gas-permeable first layer is bonded to a perimeter of said second layer" in combination with "wherein said entire first layer is gas-permeable" as recited in claim 1. Claim 14 depends from claim 1 and incorporates all of the limitations of claim 1.

Appellant further notes that the color-coded temperature indicator disclosed in Lachenbruch monitors and displays the temperature of the wrap. Appellant initially submits that the color-coded temperature indicator is not attached to a gas-permeable first layer as recited in the claims. In addition, the disclosed color-coded temperature indicator in Lachenbruch is not meant to be removed from the wrap such that (i) the color-coded temperature indicator is not detachably connected to the wrap; and (ii) the color-coded temperature indicator would not change colors if the color-coded temperature indicator were removed because the color-coded temperature indicator would not function properly if it were removed.

Appellant also submits that the color-coded temperature indicator would not provide information as what happens to the temperature of the wrap when it is removed from the wrap as recited in the claims. Therefore, Lachenbruch does not describe "wherein at least some of said plurality of portions are different colors, the colors supplying said information related to heat generated by the heat patch when one or more of said plurality of portions is removed from said gas-permeable first layer" as recited in claim 14.

***II. There is no objective evidence to combine Zhang, Kuratomi, Ingram and Lachenbruch***

The Final Office Action states at page 8 that:

"it would have been obvious to one skilled in the art to modify the heat patch of Kuratomi, Zhang and Ingram to include the color-coded temperature indicator which is taught by Lachenbruch to be able to easily see the temperature change on the skin to have

fastest response to remove it if temperature rise above the desirable temperature for therapy.”

Appellant respectfully submits that the Examiner’s statement regarding motivation is again analogous to the conclusory statements made by the Examiner and Board in the *In re Lee* case (see quote from *Lee* case above). In addition, Appellant notes that the Examiner does not cite any authority for the assertion.

Appellant respectfully submits that the only description as to (i) the entire first layer being gas-permeable; (ii) where the gas-impermeable cover includes a plurality of portions that are detachably mounted to the outer surface of the gas-permeable first layer; (iii) one of the plurality of portions including information related to heat generated by the heat patch when one or more of the plurality of portions is removed from the gas-permeable first layer; and (iv) where at least some of the plurality of portions are different colors with the colors supplying information related to heat generated by the heat patch when one or more of the plurality of portions is removed from the gas-permeable first layer is found in Appellant’s specification and claims. Appellant also fails to see how the color-coded temperature indicator disclosed in Lachenbruch would provide information related to the wrap if it is removed from the wrap as recited in the claims.

### CONCLUSION

The Appellant respectfully submits that all of the pending claims are in condition for allowance, and such action is earnestly solicited. The Examiner is invited to telephone the below-signed attorney at (262) 646-7009 to discuss any questions which may remain with respect to the present application. If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date 8-10-2007

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 10 day of August 2007.

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